

REMARKS

A. Status of the Claims

Claims 1, 2, 7, 12, 14, 19 and 25 were examined and rejected. Claims 3-11, 13 and 15-24 have been canceled. The remaining claims have been amended

B. The Pending Claims Are Patentable over the Cited References

Pending claims 1, 2 and 25 have been amended to distinguish Stinson, and for no other reason. These claims now recite that the securing material is non-radio opaque. Stinson discloses only radio opaque materials. Thus, these claims are novel over Stinson.

Further, these claims are nonobvious over Stinson and Ashley. The Office states that the need “to quickly form strong knots” provides the motivation to look to Ashley. However, no such motivation exists when viewing the references as a whole. Stinson is focused exclusively on radio opaque materials, and not on securing the intersection of two crossed strands. Stinson’s teachings are therefore inconsistent with those of the claimed subject matter. *See In re Fine*, 837 F.2d 1071, 1074-75, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988) (noting that teachings of one of cited references were “inconsistent with the claimed invention, to some extent”). Moreover, given Stinson’s focus, there is no motivation for one of ordinary skill in the art to look to Ashley. There simply is no problem for Ashley to solve. *See In re Nomiya*, 184 USPQ 607, 612-613 (CCPA 1975) (holding that it is improper to conclude that an invention is obvious absent evidence that one of ordinary skill would have recognized that an underlying problem existed).

Claims 12 and 14 are patentable over the asserted combination of Stinson and Ashley for the same reasons given above. If the Office’s asserted motivation is based on what the Examiner believes is “common knowledge” in the art, Applicant requests that the Examiner prepare an affidavit and enter it into the file history of this application pursuant to 37 C.F.R. § 1.104(d)(2).

Applicant submits that the Office's purported motivation – considering the radio opaque-centric nature of Stinson – is not “capable of such instant and unquestionable demonstration so as to defy dispute.” *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Accordingly, the Office's approach is not supported by substantial evidence. As the Federal Circuit explained in *Zurko*:

With respect to **core factual findings** in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added). The MPEP provides instruction that follows the *Zurko* decision. MPEP § 2144.03 at 2100-138 (“It is never appropriate to rely **solely** on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (citing *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697).

C. Petition for Extension of Time in This and Future Responses

Applicants petition for a 3-month extension of time in which to respond to the November 4, 2004 Office Action. The Commissioner is authorized to deduct the 3-month extension process fee, and any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, from or to Fulbright & Jaworski Deposit Account No.: 50-1212/IDEV:020US.

The Office is further authorized to treat any concurrent or future reply that requires a petition for an extension of time under 37 C.F.R. § 1.136(a) to be timely as incorporating a petition for an extension of time for the appropriate length of time, and to deduct all required fees

under 37 C.F.R. §§ 1.16 to 1.21 relating to any such replies of other relevant papers from Fulbright & Jaworski Deposit Account No.: 50-1212/IDEV:020US.

D. Conclusion

Claims 1, 2, 12, 14, and 25 are in condition for allowance. Should Examiner Pantuck have any questions, comments, or suggestions relating to this application, he is invited to contact Applicant's attorney at (512) 536-3031.

Respectfully submitted,



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